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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/767,491

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Thomas David Stephen McClelland

1981/705

5056

7590

09/28/2005

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EXAMINER

CROSLAND, DONNIE L

ART UNIT

PAPER NUMBER

2636

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,491

Applicant(s)

MCCLELLAND ET AL.

Examiner

DONNIE L. CROSLAND

Art Unit

2636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-4-04; 8-16-04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,710,708. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 17 of the Patent teaches the relative low frequency transmission and relative high frequency reception by the exciter or transmission by a secondary coil. The specific range of 3MHZ would not involve patentable invention since it is within the capabilities of the skilled artisan to discover optimum or workable ranges by routine experimentation. The courts have stated that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Swain et al*, 33 CCPA (Patents) 1250, 156 F. 2d 239, 70 USPQ 412.

Specification

The disclosure is objected to because of the following informalities: The serial number listed on page 1 of the specification should be updated with the proper Patent number.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulka et al in view of Strenglein, cite by applicants.

Kulka shows the tire monitoring system with exciter 80 and transponder 10. Kulka provides for high and low frequency signals of 2.45 GHz (obviously not claimed 3MHz, such being a matter of choice) see col. 5, lines 57-67 col. 8, and lines 26-40.

Kulka further provides for a relative high frequency signal being transmitted at the tire monitor or RFID 18; see col. 9, lines 8-21.

Accordingly, Kulka teaches the artisan that one is not limited to high or low transmissions from the exciter to the transponder and one may interchange the specified frequencies for transmission.

Strenglein, cited by applicants shows in a tire monitoring system, an exciter which transmits a low frequency as determined by low frequency generator 106 and the modulation of a high frequency signal collected by antenna 101 as generated by the tire monitor, see col. 4, lines 26-55.

It would have been obvious to one having ordinary skill in the art to provide an exciter that generates a low frequency for reception by a tire monitor and receive a high frequency signal as generated by the tire monitor in the tire monitoring system of Kulka because the specific use and suggestion of such frequency transmission and reception are clearly suggested by Strenglein.

With respect to the claimed 3MHz range, it should be noted that the specific range of 3MHZ would not involve patentable invention since it is within the capabilities of the skilled artisan to discover optimum or workable ranges by routine experimentation. The courts have stated that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Swain et al*, 33 CCPA (Patents) 1250, 156 F. 2d 239, 70 USPQ 412.

With respect to claims 2, 3, 8, 9, 17, 18, 23, 24, and 25 position is associated with the encoded data as provided by the RFID 18, see col. 5, lines 26-31.

With respect to claims 4 and 5, the recited assembly line involves use and such would not involve patentable invention.

With respect to claims 6, see col. 9.

With respect to claim 7, see col. 10, lines 32-46.

With respect to claims 10, 11, 13, and 21, see figures 7 and 8.

With respect to claim 14, note the temporary coupling of host 91 to remote exciter 80.

With respect to claim 18, patentable invention is not involved in employing plural exciters.

With respect to claims 16 and 19, due to the frequency characteristics, interference and crosstalk are naturally reduced.

With respect to claim 26, manually entering is performed with keyboard associated with host 91.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Venema shows in figure 1, an exciter that generates a relative low frequency and receives a relative high frequency signal.


Pollack et al shows an exciter with interrogation frequency F_i and response frequency F_c .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DONNIE L. CROSLAND whose telephone number is 571-272-2980. The examiner can normally be reached on Mon-Fri, 9:30a-6:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFERY HOFSSASS can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DONNIE L. GROS LAND
Primary Examiner
Art Unit 2636

Dlc
9-26-05